

ESTTA Tracking number: **ESTTA101430**Filing date: **09/27/2006**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|----------------------|--|-------------|---------|
| Name | ROLAND REIS dba R&C INTERNATIONAL COSMETICS, f/k/a R&C INTERNATIONAL COSMETICS | | |
| Entity | Sole Proprietorship | Citizenship | Germany |
| Address | Am Trimmelter Hof 56 Trier, 54206 GERMANY | | |
| Attorney information | Toby M.J. Butterfield, Matthew A. Kaplan Cowan, DeBaets, Abrahams & Sheppard LLP 41 Madison Avenue 34th Floor New York, NY 10010 UNITED STATES tbutterfield@cdas.com, mkaplan@cdas.com Phone:212-974-7474 | | |

Registration Subject to Cancellation

| | | | |
|--|--|-------------------|------------|
| Registration No | 3071704 | Registration date | 03/21/2006 |
| Registrant | Megasol Cosmetic GmbH Jean-Monnet-Strasse 6 Foehren, 54343 GERMANY | | |
| Goods/Services Subject to Cancellation | Class 003. First Use: 2000/12/19 , First Use In Commerce: 2000/12/19 Goods/Services: massage oils, excluding preparations for moisturizing or tanning the skin or for protecting the skin or hair from the effects of ultraviolet radiation | | |
| | Class 005. First Use: 2000/12/19 , First Use In Commerce: 2000/12/19 Goods/Services: Gels for use as a personal lubricant, medical lubricant, namely, vaginal lubricants, water-based personal lubricants | | |

| | |
|-------------|--|
| Attachments | Petition to Cancel Registration No. 3,074,704.pdf (55 pages)(9604736 bytes) |
|-------------|--|

| | |
|-----------|-------------------------|
| Signature | /toby m.j. butterfield/ |
| Name | Toby M.J. Butterfield |
| Date | 09/27/2006 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the Matter of Trademark Registration No. 3,071,704
For the Mark EROZONE, Registered March 21, 2006**

ROLAND REIS dba
R&C INTERNATIONAL COSMETICS,
f/k/a R&K INTERNATIONAL
COSMETICS,

Petitioner,

v.

MEGASOL COSMETIC GmbH,

Registrant/Respondent,

Cancellation No.: _____

PETITION TO CANCEL REGISTRATION NO. 3,071,704

Petitioner Roland Reis dba R&C International Cosmetics, a German sole proprietorship formerly known as R&K International Cosmetics (hereinafter, "R&C"), having its principal place of business at Am Trimmelter, Hof 56, Trier, Germany 54206, believes that it has been and will continue to be damaged by the fraudulent registration of the mark EROZONE, Registration No. 3,071,704, registered March 21, 2006 in International Classes 3 and 5. R&C therefore respectfully petitions the Trademark Trial and Appeal Board ("TTAB") to cancel the aforementioned registration.

As grounds for cancellation, R&C alleges that:

1. R&C specializes in the manufacture of the highest quality water and silicone-based lubricants for medical and personal use under the mark "E EROZONE THE FINEST FOR YOUR BODY" (hereinafter the "EROZONE" Mark). R&C markets and distributes its products under the EROZONE Mark throughout the world, including in the United States. As evidence of

the high quality of R&C's products, R&C received a Medical Device listing approval by the United States Food and Drug Administration for its EROZONE silicone-based lubricant.

2. Upon information and belief, Registrant Megasol Cosmetic GmbH ("Megasol") is a German company with a principal place of business at Jean-Monnet-Strasse 6, Foehren 54343, Germany. Megasol has been one of R&C's largest competitors since mid-1999, and similarly sells, *inter alia*, medical and personal lubricant products.

R&C's Acquisition of Trademark Registration Rights in the EROZONE Mark

3. In or around August 1999, R&C (then known as R&K International Cosmetics) was issued a trademark registration by the German Patent and Trademark Office for the EROZONE Mark, Registration No. 39921460 in International Class 3 for "massagemittel" (massage oils). A true and correct copy of the German Patent and Trademark Office trademark registration is attached hereto as Exhibit A.

4. R&C began using the EROZONE Mark in commerce in the United States since as early as November 23, 2004. Since that time, R&C has expended considerable effort and expense promoting the EROZONE Mark and the goods sold under such mark. Based upon those efforts, the purchasing public has come to know, rely upon and recognize R&C's goods by the EROZONE Mark, and R&C has established valuable good will in the EROZONE Mark.

Megasol's Attempts to Acquire Trademark Rights in the EROZONE Mark from R&C, Then Attempts To Usurp R&C's Rights Via Two Fraudulent U.S. Trademark Applications

5. In or around Spring 2002, Megasol (through its employee Bernd Kühl) attempted, unsuccessfully, to purchase the German trademark rights in the EROZONE Mark.

6. Upon information and belief, at that time, Megasol was facing a trademark infringement lawsuit in the United States involving Megasol's main brand EROS, and wanted to obtain the EROZONE brand also, in case it lost its claims to rights in the EROS mark.

7. R&C refused to sell its rights to the mark EROZONE in Germany and the rest of the world to Megasol.

8. Upon information and belief, when R&C rebuffed Megasol's attempt to purchase R&C's rights to the mark EROZONE, Megasol was determined to acquire those rights by other means, regardless of whether R&C agreed or not.

9. Notwithstanding Megasol's knowledge of R&C's rights in and to the EROZONE Mark, and without R&C's knowledge or consent, on March 13, 2003, Megasol filed two Intent-to-Use trademark applications with the United States Patent & Trademark Office ("USPTO") (the "Megasol Applications") for EROZONE, Serial No. 78/225,023 (the "'023 Mark") and EROZ-ONE, Serial No. 78/225,029 (the "'029 Mark" or "EROZ-ONE Mark"), claiming that they had a bona fide intent to use both marks in interstate commerce and claiming that no other person had such rights.

10. In fact, Megasol was neither using those marks nor had any intent to use them at that time. Rather, Megasol intended to prevent R&C from obtaining a U.S. registration of its rights to the EROZONE Mark.

11. The marks in the Megasol Applications were identical, except for the addition of an inconsequential hyphen in the '029 Mark.

12. The classes of goods and the Descriptions of Good and Services in the Megasol Applications were identical. Both covered International Classes 3 ("Perfumes, essential oils for personal use, products for body and beauty care, namely, creams, pastes, ointments, lotions, sun screen preparations, tanning lotions, soaps, massage oils") and Class 5 ("Gels for use as a personal lubricant, medical lubricant, namely vaginal lubricants, water-based personal lubricants").

13. Two days later, March 15, 2004, R&C filed an Intent-to-Use application (the "R&C Application") with the USPTO for the trademark "E EROZONE THE FINEST FOR YOUR BODY" (Serial No. 76/581,550) in International Class 5 for "Personal Lubricants."

Megasol Abandons One of Its Two Identical Applications

14. On May 12, 2004, the USPTO issued a Notice of Publication of the '029 Mark for publication on June 1, 2004. A true and correct copy of the USPTO's Notice of Publication is attached hereto as Exhibit B.

15. On July 30, 2004, R&C therefore filed with the TTAB a Notice of Opposition to the registration of the '029 Mark (the "Opposition"), which was granted Opposition No. 91161608 and instituted on or about August 5, 2004. In the Opposition, R&C asserted that the '029 Mark was likely to be confused with R&C's EROZONE Mark, which at that time R&C had already registered as their trademark in Germany, and which R&C was in the process of registering similarly with the USPTO. The Opposition also accused Megasol of deceptive and unfair trade practices.

16. A true and correct copy of R&C's Notice of Opposition is attached hereto as Exhibit C. R&C also notified the examiner on Megasol's application for the '023 Mark about the Opposition, and requested interference in that application, believing that doing so would prevent that application from resulting in a Notice of Allowance. The USPTO declined to grant the interference, however, because R&C did not pay the necessary \$100 filing fee at the correct time.

17. Megasol answered the Notice of Opposition on or about September 13, 2004.

18. On April 11, 2005, Megasol's counsel filed a Withdrawal of Application for the '029 Mark. A true and correct copy of the April 11, 2005 Withdrawal of Application is attached hereto as Exhibit D.

19. R&C did not consent to Megasol's withdrawal.

20. On April 19, 2005, the TTAB, noting that Megasol had filed its withdrawal of application without R&C's consent, entered judgment against Megasol under Trademark Rule 2.135, sustained R&C's Opposition, and refused to register the '029 Mark. A true and correct copy of the April 19, 2005 TTAB Judgment is attached hereto as Exhibit E.

Megasol Files a Fraudulent Statement of Use

21. On May 31, 2005, (following Megasol's abandonment of the '029 Mark), and in the absence of any separately filed opposition by R&C to that application, the USPTO issued a Notice of Allowance for the '023 Mark, requiring Megasol to file a Statement of Use of that mark within six months or face abandonment. A true and correct copy of the May 31, 2005 Notice of Allowance is attached hereto as Exhibit F.

22. Megasol made its application to register both the '023 and the '029 Marks on March 13, 2003 on the basis of intent to use, and had not at that time secured any trademark registration for either the '023 or the '029 Marks in Germany, where Megasol is based. Nor did Megasol claim to be using either mark in interstate commerce at the time.

23. Notwithstanding these facts, on October 20, 2005, Megasol filed a Statement of Use of the '023 Mark, wherein Megasol declared for the first time anywhere that Megasol first used the '023 Mark as early as December 19, 2000, and that it had first used in commerce at least as early as December 19, 2000. Megasol further included a specimen which purports to show such use. A true and correct copy of the Statement of Use and specimen filed with the United States Patent and Trademark Office is attached hereto as Exhibit G.

24. Upon information and belief, Megasol has, in fact, never used the term "EROZONE" as a trademark. and did not in fact use the term EROZONE as a trademark as claimed in its Statement of Use.

25. In the October 20, 2005 Statement of Use, Megasol acknowledged (through its agent Katrin Lewertoff) that willful false statements would be punishable by fine or imprisonment under 18 U.S.C. § 1001 and that such statements would jeopardize the validity of the document.

26. On November 28, 2005, despite having already filed the October 20, 2005 Statement of Use one month earlier, Megasol also filed a Statement of Use Extension Request requesting a six-month extension of time to file a Statement of Use of the '023 Mark. Instead of claiming use, Megasol declared therein that it has a bona fide intention to use the '023 Mark in connection with the goods and services listed in the Notice of Allowance, as modified. Again, Megasol (through its agent Katrin Lewertoff) acknowledged that it was warned that willful false statements would be punishable by fine or imprisonment under 18 U.S.C. § 1001 and that such statements would jeopardize the validity of the document.

27. In the circumstances, Megasol's Statement of Use of the '023 Mark was fraudulent and designed to procure a trademark registration improperly.

R&C Has Been Damaged By Megasol's Fraudulent Application

28. As described above, on March 15, 2004, two days after Megasol filed its Applications with the USPTO, R&C filed the R&C Application to register its long-standing EROZONE Mark.

29. On or about January 30, 2006, the USPTO entered a Notice of Suspension of any action on the R&C Application, pending disposition of the '023 Mark. The USPTO noted that the filing date of the application of the '023 Mark preceded the filing date of the R&C Application and that there may be a likelihood of confusion between the EROZONE Mark and the '023 Mark. A true and correct copy of the USPTO's January 30, 2006 Notice of Suspension is attached hereto as Exhibit H.

30. On February 8, 2006, the USPTO issued a Notice of Acceptance of Statement of Use of the '023 Mark, notwithstanding Megasol's unilateral withdrawal of the '029 Application and Megasol's differing representations in its October 20, 2005 Statement of Use and in its November 28, 2005 request for extension of time to file a Statement of Use. The '023 Mark was therefore registered on March 21, 2006. True and complete copies of the Notice of Acceptance of Statement of Use and the Registration Certificate are attached hereto as Exhibits I and J, respectively.

31. On or about April 4, 2006, the USPTO issued an Office Action, advising R&C that it was refusing the R&C Application on a likelihood of confusion basis because Megasol's application for the '023 Mark had resulted in a registration. A true and correct copy of the USPTO's April 4, 2006 Office Action is attached hereto as Exhibit K.

32. As the USPTO has refused to register R&C's EROZONE Mark because of Megasol's fraudulent trademark application and registration, R&C has been and will continue to be irreparably damaged if Registration 3,071,704 is not cancelled.

I. REGISTRATION OF THE '023 MARK IS BARRED BY *RES JUDICATA*.

33. By abandoning its Application for the '029 Mark "EROZ-ONE" without R&C's consent during the Opposition, the TTAB's Order entering judgment against Megasol, sustaining R&C's Opposition and refusing to register the EROZ-ONE Mark, operated as a judgment with prejudice and final judgment on the merits of R&C's Opposition.

34. The parties to the instant Petition for Cancellation are the same as those that participated in the Opposition to the EROZ-ONE Mark.

35. The marks involved in the instant Petition for Cancellation ("EROZONE") and the Opposition ("EROZ-ONE") are identical except for the inclusion of an inconsequential

hyphen, involve the same goods in the same International Classes, and have the same commercial impression.

36. Registration of Megasol's '023 Mark thus should be cancelled because it is barred by *res judicata*.

II. REGISTRATION OF THE '023 MARK WAS PROCURED BY FRAUD.

37. Megasol obtained registration of the '023 Mark fraudulently, in that Megasol's initial Intent to Use Applications, and its subsequent Statement of Use, filed under oath with notice of 18 U.S.C. § 1001, stated that Megasol had an intent to use both marks.

38. Megasol obtained registration of the '023 Mark fraudulently, in that Megasol's Statement of Use, filed under oath with notice of 18 U.S.C. § 1001, stated that Megasol first used the '023 Mark as early as December 19, 2000 and first used said mark in interstate commerce as early as December 19, 2000 and was using the mark at the time of filing the Statement of Use.

39. Upon information and belief, those statements were false, because at the time of Megasol's filing of its Applications it had no such intent; and because at the time of Megasol's filing of its Statement of Use, Megasol had not used the '023 Mark as of the dates noted and as of the filing date of the Statement of Use. Indeed, Megasol has not done so since that time.

40. Further, Megasol never intended to use the '023 Mark, and, instead, improperly and fraudulently registered the mark to preclude R&C from obtaining registration, even though R&C had prior rights in the EROZONE Mark of which Megasol was aware.

41. The false statements were made by an authorized agent of Megasol with the knowledge and belief that said statement was false.

42. Megasol's false statements were made with the intent to induce the USPTO to grant registration in the '023 Mark. The USPTO, reasonably relying upon the truth of those false statements did, in fact, grant registration in the '023 Mark to Megasol.

43. As R&C's application for the EROZONE Mark has been refused by the USPTO due to the '023 Mark's fraudulent registration, R&C has been damaged, because R&C's continued and legal use of the EROZONE Mark since November 2004 will be impaired by the continued registration of Megasol's '023 Mark.

44. Registration of Megasol's '023 Mark thus should be cancelled because the registration was procured by fraud.

III. THERE IS A LIKELIHOOD OF CONFUSION BETWEEN THE '023 MARK AND THE EROZONE MARK.

45. Alternatively, Megasol's '023 Mark so resembles R&C's EROZONE Mark that registration and any future use thereof is likely to cause confusion, mistake and deception as to the source or origin of R&C's goods and will injure and damage R&C.

46. R&C began using its EROZONE Mark in the United States prior to the Application date of the '023 Application.

47. Megasol's goods are identical and/or substantially similar to R&C's goods, and as a result, the public is likely to be confused, to be deceived, and/or to assume erroneously that Megasol's goods are those of R&C, or that Megasol is in some way connected with or sponsored by or affiliated with R&C, all to R&C's irreparable damage.

WHEREFORE, as R&C believes that it will be seriously damaged by said registration, R&C, by its undersigned attorneys, respectfully requests that the Trademark Trial and Appeal Board CANCEL Registration No. 3,071,704 for the mark EROZONE in International Classes 3 and 5 for all requested goods.


A duplicate copy of this Petition for Cancellation is enclosed herewith. The Trademark Trial and Appeal Board is hereby authorized to charge the fee of \$600 (\$300 per mark per class) required in 37 C.F.R. § 2.6(a)(17) and any additional fees that may be required as well as credit any overpayments to our Deposit Account No. 50-1639, in the name of Cowan, DeBaets, Abrahams & Sheppard, LLP.

Dated: New York, New York
September 26, 2006

Respectfully submitted,

COWAN, DeBAETS, ABRAHAMS & SHEPPARD LLP

By:


Toby M.J. Butterfield
Matthew A. Kaplan
41 Madison Avenue, 34th Floor
New York, New York 10010
(212) 974-7474

Attorneys for R&C International Cosmetics


A duplicate copy of this Petition for Cancellation is enclosed herewith. The Trademark Trial and Appeal Board is hereby authorized to charge the fee of \$600 (\$300 per mark per class) required in 37 C.F.R. § 2.6(a)(17) and any additional fees that may be required as well as credit any overpayments to our Deposit Account No. 50-1639, in the name of Cowan, DeBaets, Abrahams & Sheppard, LLP.

Dated: New York, New York
September 26, 2006

Respectfully submitted,

COWAN, DeBAETS, ABRAHAMS & SHEPPARD LLP

By:


Toby M.J. Butterfield
Matthew A. Kaplan
41 Madison Avenue, 34th Floor
New York, New York 10010
(212) 974-7474

Attorneys for R&C International Cosmetics

DPINFO

**German Patent and Trade Mark Office****Trade Mark Register**

Query started: 27.09.2006 20:56:42

**Registernumber/File
number:****39921460.7****SG01 - Short overview****Trade mark text:**e EROZONE THE FINEST FOR
YOUR BODY**Type of mark:**

Wort-/Bildmarke

Owner:

Reis, Roland, 54294 Trier

Leading class:

03

Classes:

03

Legal/procedural status:

Marke eingetragen

SG10 - General information**Trade mark text:**e EROZONE THE FINEST FOR
YOUR BODY**Type of mark:**

Wort-/Bildmarke

Colours:

gelb, weiß

Categories of figurative elements:

27.05.10; 27.05.21; 29.01.13

Legal/procedural status:

Marke eingetragen

SG15 - Owner, representative**Name and residence/seat
of applicant/owner of trade mark:**

Reis, Roland, 54294 Trier

Address for service :R&K Vertrieb International Roland
Reis
Am Trimmelter Hof 56
54296 Trier**SG20 - Goods/services (current state of database)****Leading class:**

03

Classes:

03

Goods/services (current state of database):**Class 03:**

Massagemittel, soweit in Klasse 3
enthalten

SG30 - Procedure (chronology)

Filing date: 15.04.1999

Date of registration: 17.08.1999

**Date of publication of the
registration:** 16.09.1999

SG40 - Opposition procedure

Marke ohne Widerspruch eingetragen

SG50 - Divisions**SG55 - Transfers of rights, partial transfers of rights**

Bis: 26.04.2000

Name und Anschrift des früheren Inhabers der Marke:
Reis, Roland, 54294 Trier; Karl, Bernd, 54329 Konz

SG60 - Cancellations, partial cancellations**SG70 - Rights in rem, levy of execution, insolvency/bankruptcy
proceedings****SG80 - Modifications relating to owner and representative****SG90 - Corrections**

Berichtigung vom: 07.08.2002
Änderung der Zustelladress;

Berichtigung vom: 20.08.2003
Änderung der Zustelladresse

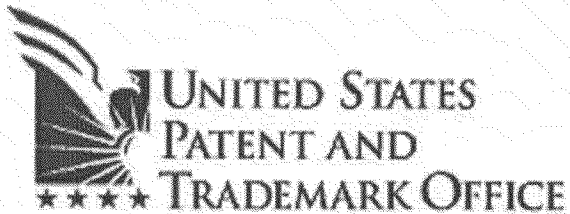


DISPLAY
IMAGE

Representation of the trade mark 39921460.7



EXHIBIT B



Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
www.uspto.gov

May 12, 2004

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|-------------------------------------|--|
| 1. Serial No.: 78/225,029 | 2. Mark: EROZ-ONE |
| 3. International Class(es): 3, 5 | |
| 4. Publication Date: Jun 1, 2004 | 5. Applicant: Megasol Cosmetic GmbH |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202) 512-1800

By direction of the Commissioner.

Correspondence Address:

David Toren
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York NY USA 10019

TMP&I

EXHIBIT C

ESTTA Tracking number: **ESTTA12677**

Filing date: **07/30/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|--|---|
| Name | Horst Weininger of WHR International and Roland Reis of R&K International |
| Granted to Date of previous extension | 07/31/2004 |
| Address | Horst Weininger of WHR International and Roland Reis of R&K International Am Trimmelter Hof 56 Trier, 54296 GERMANY |

| | |
|-----------------------------|---|
| Attorney information | Marshall Lee Miller BAISE & MILLER P.C. 1020 19th Street, NW suite 400 Washington, DC 20036-6101 UNITED STATES miller@baisemiller.com Phone:202-331-9100 |
|-----------------------------|---|

Applicant Information

| | | | |
|-------------------------------|------------|-------------------------------|------------|
| Application No | 78225029 | Publication date | 06/01/2004 |
| Opposition Filing Date | 07/30/2004 | Opposition Period Ends | 07/31/2004 |

| | |
|------------------|-----------------------|
| Applicant | Megasol Cosmetic GmbH |
|------------------|-----------------------|

Goods/Services Affected by Opposition

Class 003. First Use: First Use In Commerce:

All goods and services in the class are opposed, namely: Perfumes, essential oils for personal use, products for body and beauty care, namely, creams, facial mask paste, non-medicated skin moisturizing ointments, lotions, sun screen preparations, tanning lotions, soaps, massage oils

Class 005. First Use: First Use In Commerce:

All goods and services in the class are opposed, namely: Gels for use as a personal lubricant, medical lubricant, namely, vaginal lubricants, water-based personal lubricants

Opposer has information and belief that Applicant Megasol has a pending publication in the Official Gazette, on August 10, 2004, of an additional trademark application for the name, Erozone. Trademark application Serial number 78225023.

| | |
|--------------------|---|
| Attachments | 78225029 Opposition RandK.pdf (7 pages) |
|--------------------|---|

| | |
|------------------|-----------------------|
| Signature | /Marshall Lee Miller/ |
| Name | Marshall Lee Miller |
| Date | 07/30/2004 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of: Trademark application Serial number - 78225029
For the mark: Erozone
Published in the Official Gazette on: June 1, 2004

R&K International Cosmetics
Through Horst Weininger and Roland Reis
Am Trimmelter, Hof 56
Trier, Germany 54296

v.

Megasol Cosmetic GmbH
Jean-Monnet-Strasse 6
Fohren, Germany 54343

NOTICE OF OPPOSITION

The above-identified opposer, R&K International Cosmetics (hereinafter R&K), through its officers Horst Weininger and Roland Reis, believes that it will incur substantial commercial damages and egregious infringement of intellectual property rights, by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer R&K claims standing in this matter as legal owner of the Trademark "Erozone" in the Federal Republic of Germany since August 1999. (Exhibit A attached).
2. Opposer R&K's product, Erozone, is a personal lubricant.
3. Opposer R&K asserts its right in protecting its suggestive trade name "Erozone", and has marketed products under the name "Erozone" in Germany for at least five years. In

addition to the suggestive nature of the trademark and trade name, "Erozone," the product's name has acquired significant and substantial secondary meaning.

4. Opposer R&K has filed an application for the mark "Erozone" with the United States Patent and Trademark Office (USPTO) in February 2004 in order to protect its name while preparing its product for importation and distribution in the U.S. market (Exhibit B attached).

5. Applicant Megasol is a German national in the same line of business as Opposer R&K and has knowledge of Opposer's Erozone German trademark and product. Applicant Megasol's business address is within walking distance of Opposer R&K's business address in the German town of Trier, and the companies know each other well.

6. Applicant Megasol's product is also a personal lubricant, and is substantially indistinguishable from Opposer R&K's product.

7. Applicant Megasol markets its product in Germany under the names, "Megasol Eros" and "Pur Eros." Applicant Megasol does not have a legal interest in the name "Erozone" or "Eroz-one" in the Federal Republic of Germany.

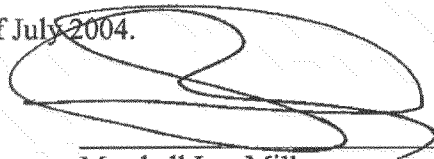
8. Applicant Megasol's marketing of a substantially indistinguishable product in the U.S. market under the mark "Eroz-one" would amount to common law misappropriation.

9. Applicant Megasol is attempting to willfully appropriate Opposer R&K's German mark in order to create confusion within the U.S. market in violation of the Lanham Trade-Mark Act, 15 U.S.C.A. §1051, et seq.

10. Applicant Megasol's marketing a substantially indistinguishable product in the U.S. market is an impermissible attempt at the passing off of Applicants Megasol's product for that marketed by Opposer R&K in the European market, and misappropriating Opposer R&K's secondary meaning for its "Erozone" trademark.

11. Applicant Megasol willful intent to appropriate Opposer R&K's Trademark "raises an inference of likelihood of confusion" and may therefore raise a cause of action for trademark infringement pursuant to the Lanham Trade-Mark Act. See *Squirt Company v. Seven-Up Co.*, 628 F.2d 1086 (1980).
12. Applicant Megasol's use of the name "Eroz-one" in the US market would most likely be actionable as unlawful before the Federal Trade Commission under 15 USC §45 for unfair competition and "unfair or deceptive acts or practices."
13. Opposer R&K is preparing its product for lawful distribution in the U.S. through compliance with the requirements of the Food, Drug and Cosmetic Act and regulations governing the use and distribution of its product, Erozone, by having submitted appropriate applications to the U.S. Food and Drug Administration (Exhibit C attached).
14. Opposer R&K has prepared for mass distribution of its product in North America through contacting of potential distributors, marketing plans, shipments of product samples to selected test markets on the East and West Coasts, and establishing commercial contacts within North America in order to execute a broader marketing plan.
15. Opposer R&K requests oral argument in conjunction with this Notice of Opposition.

Respectfully submitted this 30th day of July 2004.



Marshall Lee Miller

Attorney for R&K International Cosmetics

Baise & Miller, P.C.
1020 19th Street, NW, Suite 400
Washington, DC 20036
Telephone: (202) 331-9100
Facsimile: (202) 331-9060


Bibliographic data
INID Criterion

(111) Register number
 (210) File number
 (540) Reproduction of the trade mark
 (540) Reproduction of the trade mark
 (550) Type of mark
 (591) Colours
 (220) Application date
 (151) Date of entry into the register
 (450) Date of publication of the registration
 (732) Proprietor
 (750) Address for service/ recipient

 (511) Leading class
 (510) List of goods/services
 (531) Vienna Classification of the Figurative
 Elements of Marks

Field Content

RN 39921460
 AKZ 39921460.7
 WM e EROZONE THE FINEST FOR YOUR BODY
 WM
 MF Word/figurative mark (WBM)
 FA gelb, weiß
 AT 04/15/1999
 ET 08/17/1999
 VT 09/16/1999
 INH Reis, Roland, Trier, DE
 ZUE R&K Vertrieb International, Roland Reis,
 Kirchstr. 24, 54311 Trierweiler
 LK 03
 WDV Massagemittel, soweit in Klasse 3 enthalten.
 WBK 27.05.10, 27.05.21, 29.01.13

Alterations

| Part | Week | Reason | New content |
|------|---------|---------------------|--|
| 8cde | 38/2003 | Correction (324) | Zuän R&K Vertrieb International, Roland Reis, Am Trimmelter Hof 56, 54296 Trier |

 Further information (legal status information) on this document: **DPINFO**

Download: [Bibliographic data XML](#) | [Bibliographic data DTD](#)
[Back to result list](#) | [Print](#) | [Close window](#)



Deutsches Patent- und Markenamt

[Home](#) · [Information](#) · [Introduction](#) · [Links](#) · [Imprint](#) · [Help](#)

[Patents and utility models](#) | [Trade marks](#) | [Industrial designs](#)

[Search Beginner](#) > [Result list](#) [Download](#) | [Beginner](#) | [Expert](#) | [Assistant](#) | [Nice Classification](#) | [Vienna Classifi](#)

Search request

AKZ = "39921460.7"

Result list: 1 results

No. (111) Register number

1 39921460

(540) Reproduction of the trade mark

a EROZONE THE FINEST FOR YOUR BODY

|< < > >|

FILING RECEIPT FOR TRADEMARK APPLICATION

Page 01 of 01

Ex B

Apr 6, 2004

This acknowledges receipt on the FILING DATE of the application for registration for the mark identified below. The FILING DATE is contingent upon all minimum filing date requirements being met. Your application will be considered in the order in which it was received. Action on the merits should be expected from the United States Patent and Trademark Office (USPTO) approximately six months from the FILING DATE. When inquiring about this application, include the SERIAL NUMBER, FILING DATE, OWNER NAME and MARK.

BRYAN BRENDLE
BAISE & MILLER, PC
1020 19 TH STREET, NW, SUITE 400
WASHINGTON, DC 20036

ATTORNEY
REFERENCE NUMBER
39921460.7

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the filing receipt should be submitted within 30 days. Such request may be submitted by mail to: COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3514; by fax to 703-308-9096; or by e-mail to tmfilingreceipt@uspto.gov. The USPTO will review the request and make corrections when appropriate.

SERIAL NUMBER: 76/581550
FILING DATE: Mar 15, 2004
REGISTER: Principal
LAW OFFICE: 110
MARK: EROZONE THE FINEST FOR YOUR BODY
MARK TYPE(S): Trademark
DRAWING TYPE: Stylized words, letters, or numbers
FILING BASIS: Sect. 1(b) (Intent to Use)

RECEIVED**APR 08 2004**

Baise & Miller, P.C.

DOMESTIC REPRESENTATIVE: Bryan Brendle

OWNER: Roland Reis (NOT PROVIDED, Unknown)
R&K International Cosmetics
Am Trimmelter Hof 56
Trier, FED REP GERMANY 54296

FOR: Personal Lubricant- product label, appears on the container for the goods, or displays and advertisements associated with the product
INT. CLASS: 005

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

OTHER DATA

DESCRIPTION OF MARK: The stylized "e" is ballooned with black shading around the inner edges with a slight light blue shading at the top inner edge

LINING AND STIPPLING STATEMENT: Yellow, Blue, Grey (Stippling) Stippling in background is for shading purposes only.

DEPARTMENT OF HEALTH AND HUMAN SERVICES

Public Health Service

Food and Drug Administration
Center for Devices and
Radiological Health
2098 Gaither Road
Rockville, Maryland 20850

April 29, 2004

Re: FDA Registration Form
Owner/Operator No: 9061295

Mr. Bryan Brendle
Baise & Miller, P.C.
1020 19th Street N.W.
Suite 400
Washington, DC 20036

RECEIVED

MAY 03 2004

Baise & Miller, P.C.

Dear Mr. Bryan Brendle:

We have received your form FDA 2891, Initial Registration of Device Establishment, and form FDA 2892, Medical Device Listing for the following medical device establishment:

R & K International Cosmetics
Am Trimmelter, Hof 56
Trier 54296 Germany

This information has been entered into our Establishment Registration database. We will forward your establishment registration number to you after the Field Investigations, Office of Regional Operations, Food and Drug Administration (FDA) assigns it. Nevertheless, until that time, you are still considered registered.

Please refer to the Owner/Operator Number when you or your United States Agent contacts our Branch with any subsequent correspondence.

FDA sends form FDA 2891a, Annual Registration, to all registered firms annually to be verified, corrected, and returned to us. Your copy of Part 1 is proof of registration for the coming year.

We do not acknowledge receipt of device listing forms received subsequent of an establishment initial registration. Please keep the yellow copy, or a photocopy, of each form FDA 2892 as proof of your listing. The listing form document number in the upper left corner specifically identifies the listed device. The document number should be included on all shipping invoices.

Any inquiries regarding your registration status or device listing should be directed to the registration and listing staff at 011-1-301-827-4555.

Sincerely yours,

Lisa M. King
for Lisa M. King
Consumer Safety Officer
Registration and Listing Program
Office of Compliance
Center for Devices and Radiological Health

EXHIBIT D

ESTTA Tracking number: **ESTTA30191**

Filing date: **04/11/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|-----------------------------------|--|
| Proceeding | 91161608 |
| Party | Defendant Megasol Cosmetic GmbH Megasol Cosmetic GmbH Jean-Monnet-Strasse 6 DEX Foehren, 54343 |
| Correspondence Address | DAVID TOREN SIDLEY AUSTIN BROWN & WOOD LLP 787 SEVENTH AVENUE NEW YORK NY U, SA 10019 |
| Submission | Withdrawal Of Appplication |
| Filer's Name | David Toren |
| Filer's e-mail | kzuehlke@sidley.com |
| Signature | /David Toren/ |
| Date | 04/11/2005 |
| Attachments | DT-6884 withdrawal of app.pdf (2 pages) |

DT-6884

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HORST WEININGER OF WHR
INTERNATIONAL AND
ROLAND REIS OF
R&K INTERNATIONAL COSMETICS

Opposer,

v.

MEGASOL COSMETIC GMBH

Applicant.

Opposition No. 91161608

Mark: **EROZ-ONE**

Serial No.: 78225029

Filing Date: March 13, 2003

Published: June 1, 2004

WITHDRAWAL OF APPLICATION

Applicant, by its attorneys, hereby withdraws its application Serial No. 78/225,029.

Respectfully submitted,

MEGASOL COSMETIC GMBH

Dated: April 11, 2005

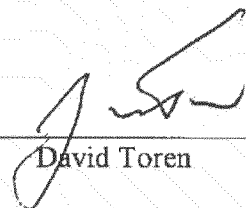
By: 

David Toren
Attorney for Applicant
SIDLEY AUSTIN BROWN & WOOD LLP
787 Seventh Avenue
New York, New York 10019

Certificate of Service

The undersigned hereby certifies that a true and correct copy of the foregoing was served this 11th day of April 2005 on counsel for Opposer by first-class U.S. mail, postage prepaid, addressed as follows:

Marshall Lee Miller
Baise & Miller, P.C.
1020 19th Street, NW, Suite 400
Washington, DC 20036



David Toren

EXHIBIT E

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

vw/LCJ

Mailed: April 19, 2005

Opposition No. 91161608

Horst Weininger of WHR
International and Roland
Reis of R&K International
Cosmetics

v.

Megasol Cosmetic GmbH

Veronica White, Paralegal Specialist:

On April 11, 2005, applicant filed an abandonment of its application Serial No. 78/225029.

Trademark Rule 2.135 provides that if, in an inter partes proceeding, the applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against applicant.

In view thereof, and because opposer's written consent to the abandonment is not of record, judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.

***By the Trademark Trial
and Appeal Board***

EXHIBIT F

U.S. Patent and Trademark Office (USPTO)

NOTICE OF ALLOWANCE

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 571-273-9550. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: May 31, 2005

DAVID TOREN
SIDLEY AUSTIN BROWN & WOOD LLP
787 SEVENTH AVENUE
NEW YORK NY U, SA 10019

ATTORNEY
REFERENCE NUMBER

DT-6469

**** IMPORTANT INFORMATION: 6 MONTH DEADLINE ****

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION.

Please note that both the "Statement of Use " and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at <http://www.uspto.gov/teas/index.html> (under "File a PRE-registration form"), to avoid the possible omission of important informaton. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

The following information should be reviewed for accuracy:

SERIAL NUMBER: 78/225023
MARK: EROZONE
OWNER: Megasol Cosmetic GmbH
Jean-Monnet-Strasse 6
Foehren , FED REP GERMANY 54343

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO

Section 1(b): YES

Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

- 003 - Perfumes, essential oils for personal use, soaps, and massage oils, excluding preparations for moisturizing or tanning the skin or for protecting the skin or hair from the effects of ultraviolet radiation
- 005 - Gels for use as a personal lubricant, medical lubricant, namely, vaginal lubricants, water-based personal lubricants

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS

EXHIBIT G

Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

| Input Field | Entered |
|-------------------------------|--|
| SERIAL NUMBER | 78225023 |
| LAW OFFICE ASSIGNED | LAW OFFICE 112 |
| NOTICE OF ALLOWANCE | YES |
| EXTENSION OF USE | NO |
| REQUEST TO DIVIDE | NO |
| MARK SECTION | |
| STANDARD CHARACTERS | NO |
| LITERAL ELEMENT | EROZONE |
| OWNER SECTION (no change) | |
| ATTORNEY SECTION (current) | |
| NAME | David Toren |
| DOCKET NUMBER | DT-6469 |
| ATTORNEY SECTION (proposed) | |
| NAME | Katrin Lewertoff and Peter J. Toren |
| DOCKET NUMBER | DT-6469 |
| GOODS AND/OR SERVICES SECTION | |
| INTERNATIONAL CLASS | 003 |
| GOODS AND/OR SERVICES | KEEP ALL LISTED, EXCEPT perfumes, essential oils for personal use, soaps |
| FIRST USE ANYWHERE DATE | 12/19/2000 |
| FIRST USE IN COMMERCE DATE | 12/19/2000 |
| SPECIMEN FILE NAME(S) | \\TICRS\EXPORT8\IMAGEOUT8\782\250\78225023\xml1\SOU0002.JPG |
| SPECIMEN DESCRIPTION | scanned label |
| INTERNATIONAL CLASS | 005 |
| GOODS AND/OR SERVICES | KEEP ALL LISTED |
| FIRST USE ANYWHERE DATE | 12/19/2000 |
| FIRST USE IN COMMERCE DATE | 12/19/2000 |
| SPECIMEN FILE NAME(S) | \\TICRS\EXPORT8\IMAGEOUT8\782\250\78225023\xml1\SOU0003.JPG |
| SPECIMEN DESCRIPTION | scanned label |
| PAYMENT SECTION | |

| | |
|---------------------------|--|
| NUMBER OF CLASSES | 2 |
| SUBTOTAL AMOUNT | 200 |
| TOTAL AMOUNT | 200 |
| SIGNATURE SECTION | |
| SIGNATURE | /Katrin Lewertoff/ |
| SIGNATORY NAME | Katrin Lewertoff |
| SIGNATORY DATE | 10/20/2005 |
| SIGNATORY POSITION | Attorney |
| FILING INFORMATION | |
| SUBMIT DATE | Thu Oct 20 14:09:12 EDT 2005 |
| TEAS STAMP | USPTO/SOU-198.232.62.11-2 0051020140912125113-78225 023-2509379b8d2ba83ac738a d49dd7f874e3-DA-1565-2005 1020135900557411 |

PTO Form 1051 (Rev. 4/2000)

© Mark C. Lewis (2003) - 0009 (1/03) 46/3a/2a/03/03

Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

To the Commissioner for Trademarks:

MARK: EROZONE

SERIAL NUMBER: 78225023

This Allegation of Use is being filed after a Notice of Allowance has issued.

The applicant, Megasol Cosmetic GmbH, residing at Jean-Monnet-Strasse 6, Fochren, Germany 54343, is using or is using through a related company or licensee the mark in commerce on or in connection with the goods and/or services as follows:

For International Class: 003, the applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance, except the following: perfumes, essential oils for personal use, soaps. The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 12/19/2000, and first used in commerce at least as early as 12/19/2000, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) scanned label.

Specimen-1

For International Class: 005, the applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 12/19/2000, and first used in commerce at least as early as 12/19/2000, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) scanned label.

Specimen-1

The applicant hereby appoints Katrin Lewertoff and Peter J. Toren to submit this Trademark/Service Mark Statement of Use on behalf of the applicant. The attorney docket/reference number is DT-6469.

A fee payment in the amount of \$200 will be submitted with the form, representing payment for 2 classes.

Declaration

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Katrin Lewertoff/ Date: 10/20/2005

Signatory's Name: Katrin Lewertoff

Signatory's Position: Attorney

RAM Sale Number: 1565

RAM Accounting Date: 10/20/2005

Serial Number: 78225023

Internet Transmission Date: Thu Oct 20 14:09:12 EDT 2005

TEAS Stamp: USPTO/SOU-198.232.62.11-2005102014091212

5113-78225023-2509379b8d2ba83ac738ad49dd

7f874e3-DA-1565-20051020135900557411

[Go Back](#)



Art.-Nr.
E 12041

Meissner GmbH
Jean-Monnet-Strasse 6
D-54343 Föhren
Phone ++49 (0)4502/20011 Fax 20187



4 035223 120415

M EROZONE Bodyglide per la vostra pelle sensibile. È un prodotto molto delicato, che non irrita la pelle. **Qualità:** solo i migliori ingredienti. **Caratteristiche:** non irrita la pelle, non lascia tracce, non lascia odore, non lascia untuosità. **Indicazioni:** per uso quotidiano. **Confezione:** 100 ml / 3.4 fl.oz. **Prezzo:** 12,00 €.

M EROZONE Bodyglide per la vostra pelle sensibile. È un prodotto molto delicato, che non irrita la pelle. **Qualità:** solo i migliori ingredienti. **Caratteristiche:** non irrita la pelle, non lascia tracce, non lascia odore, non lascia untuosità. **Indicazioni:** per uso quotidiano. **Confezione:** 100 ml / 3.4 fl.oz. **Prezzo:** 12,00 €.

Ingredients (INCI):
Dimethicone and
Dimethiconol
cyclomethicone

1/1K 03 100 ml / 3.4 fl.oz

M EROZONE



super concentrated
BODYGLIDE

Lotus Safe - Made in Germany

M EROZONE Bodyglide is designed for delicate skin. It is a very delicate product, which does not irritate the skin. **Quality:** only the best ingredients. **Characteristics:** does not irritate the skin, does not leave traces, does not leave odor, does not leave greasiness. **Indications:** for daily use. **Package:** 100 ml / 3.4 fl.oz. **Price:** 12.00 €.

M EROZONE Bodyglide is designed for delicate skin. It is a very delicate product, which does not irritate the skin. **Quality:** only the best ingredients. **Characteristics:** does not irritate the skin, does not leave traces, does not leave odor, does not leave greasiness. **Indications:** for daily use. **Package:** 100 ml / 3.4 fl.oz. **Price:** 12.00 €.

M EROZONE Bodyglide is designed for delicate skin. It is a very delicate product, which does not irritate the skin. **Quality:** only the best ingredients. **Characteristics:** does not irritate the skin, does not leave traces, does not leave odor, does not leave greasiness. **Indications:** for daily use. **Package:** 100 ml / 3.4 fl.oz. **Price:** 12.00 €.

ArL-Nr.
E 1204

Fax 20187

Megasol GmbH
Jean-Monnet-Straße 6
D-54343 Föhren



035223 120415

[illegible][illegible]

Ingredients (INCI):
Dimethicone and
Dimethicone
Cyclomethicone

1/K 03 100 ml / 3.4 fl.oz

**M
ERONE**



super concentrated
BODYGLIDE

Latex Safe Mark® in Germany

1. KNOXONE Polyethylene is different from other types of plastics. It is a thermoplastic, which means that it can be softened by heat and reshaped. It is also a tough plastic, which means that it is resistant to impact and abrasion. It is used in a wide variety of products, including bottles, containers, and packaging. **Characteristics:** It is a tough, flexible plastic that is resistant to impact and abrasion. It is also a thermoplastic, which means that it can be softened by heat and reshaped. It is used in a wide variety of products, including bottles, containers, and packaging. **Directions for use:** It is used in a wide variety of products, including bottles, containers, and packaging. It is a tough, flexible plastic that is resistant to impact and abrasion. It is also a thermoplastic, which means that it can be softened by heat and reshaped. It is used in a wide variety of products, including bottles, containers, and packaging.

[illegible]

Anwendung: Neben der bei Handig und Co. von **PIKROZONE** (Gehblase) und -homogenat mit der Körpergröße im Alter von 10 Jahren (ausreichend) zu sein, gebildet sie das einjährige, Gefühl von **PIKROZONE** besteht:

[illegible]

FEE RECORD SHEET

Serial Number: 78225023



RAM Sale Number: 1565

Total Fees: \$200

RAM Accounting Date: 20051020

| <u>Transaction</u> | <u>Fee Code</u> | <u>Transaction Date</u> | <u>Fee per Class</u> | <u>Number of Classes</u> | <u>Total Fee</u> |
|------------------------|---------------------|-----------------------------|--------------------------|------------------------------|----------------------|
| Statement of Use (SOU) | 7003 | 20051020 | \$100 | 2 | \$200 |

Transaction Date: 20051020



EXHIBIT H

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/581550

APPLICANT: Roland Reis

76581550

CORRESPONDENT ADDRESS:

Marshall Lee Miller
Baise & Miller, PC
PO Box 14368
Washington DC 20044-4368

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should include the words

"Box Responses - No Fee."

MARK: E EROZONE THE FINEST FOR YOUR BODY

CORRESPONDENT'S REFERENCE/DOCKET NO: 39921460.7

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

Serial Number 76/581550

NOTICE OF SUSPENSION

SUSPENSION PROCEDURE: This suspension notice serves to suspend action on the application for the reason(s) specified below. No response is needed. 37 C.F.R. §2.67. However, the examining attorney will conduct periodic status checks and may issue inquiries at 6 month intervals from the mailing date of this notice. TMEP §716.05. If a status inquiry Office action issues, applicant will have 6 months from the mailing or e-mailing date of the status inquiry to respond. 15 U.S.C. §1062(b); 37 C.F.R. §2.62.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Action on this application is suspended pending the disposition of: 78225023.

Information regarding pending Application Serial No. 78225023 was sent previously. The filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

The amended identification and clarification of applicant's entity type have been entered for the record.

/kbp/

Kimberly Boulware Perry

Attorney - Law Office 112

phone: 571-272-9208; fax: 571-273-9112

direct email: kimberly.perry@uspto.gov

EXHIBIT I



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

NOTICE OF ACCEPTANCE OF STATEMENT OF USE

Feb 8, 2006

TM12

**ATTORNEY
REFERENCE NUMBER:**

DT-6469

Katrin Lewertoff
SIDLEY AUSTIN BROWN & WOOD LLP
787 SEVENTH AVENUE
NEW YORK NY 10019

| | |
|-----------------------|-----------------------|
| SERIAL NUMBER: | 78/225023 |
| MARK: | EROZONE |
| OWNER: | Megasol Cosmetic GmbH |

The Statement of Use (SOU) filed for the trademark application identified above has been accepted. This acceptance means that the mark will register and the registration certificate will issue in due course barring any extraordinary circumstances.

For further information please check the USPTO web site at www.uspto.gov or call the Trademark Assistance Center at 1-800-786-9199.

EXHIBIT J

Int. Cls.: 3 and 5

Prior U.S. Cls.: 1, 4, 6, 18, 44, 46, 50, 51, and 52

United States Patent and Trademark Office

Reg. No. 3,071,704

Registered Mar. 21, 2006

**TRADEMARK
PRINCIPAL REGISTER**

EROZONE

MEGASOL COSMETIC GMBH (FED REP GER-
MANY LTD LIAB JT ST CO)
JEAN-MONNET-STRASSE 6
FOEHREN, FED REP GERMANY 54343

FOR: MASSAGE OILS, EXCLUDING PREPARA-
TIONS FOR MOISTURIZING OR TANNING THE
SKIN OR FOR PROTECTING THE SKIN OR HAIR
FROM THE EFFECTS OF ULTRAVIOLET RADIA-
TION, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 12-19-2000; IN COMMERCE 12-19-2000.

FOR: GELS FOR USE AS A PERSONAL LUBRI-
CANT, MEDICAL LUBRICANT, NAMELY, VAGI-
NAL LUBRICANTS, WATER-BASED PERSONAL
LUBRICANTS, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46,
51 AND 52).

FIRST USE 12-19-2000; IN COMMERCE 12-19-2000.

SN 78-225,023, FILED 3-13-2003.

DAVID TAYLOR, EXAMINING ATTORNEY

EXHIBIT K

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/581550

APPLICANT: Roland Reis

76581550

CORRESPONDENT ADDRESS:

Marshall Lee Miller
Baise & Miller, PC
PO Box 14368
Washington DC 20044-4368

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: E EROZONE THE FINEST FOR YOUR BODY

CORRESPONDENT'S REFERENCE/DOCKET NO: 39921460.7

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 76/581550

Action on this application was previously suspended pending the disposition of Application Serial No. 78225023. The referenced pending application has since registered. Therefore, registration is now refused as follows.

Section 2(d) - Likelihood of Confusion Refusal

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 3071704 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the parties' goods to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

Applicant's mark is E EROZONE THE FINEST FOR YOUR BODY. The registered mark is EROZONE. The dominant term in the applicant's mark is identical to the registered mark. When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted).

It is well settled that the parties' goods need not be identical or directly competitive to find a likelihood of confusion. Rather, the goods need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In this case, however, the parties' goods which include the applicant's "Water-based Personal Lubricants" and the registrant's "Gels for use as a personal lubricant, medical lubricant, namely, vaginal lubricants, water-based personal lubricants" are highly related, if not identical, and directly competitive.

When confronted with the parties' goods, as used in connection with highly similar marks, purchasers will mistakenly believe that the goods originate from the same source. The examining attorney is bound to resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence in support of registration.

Applicant may wish to hire a specialist attorney to assist in prosecuting this application because of the technicalities involved. The Office cannot aid in the selection of a trademark attorney. 37 C.F.R. §2.11. Applicant may wish to consult the Yellow Pages for a listing of attorneys specializing in trademark or intellectual property law, or seek guidance from its local Bar Association attorney-referral service.

The following legal authorities govern the processing of trademark and service mark applications by the Office: The Trademark Act, 15 U.S.C. §§1051 *et seq.*, the Trademark Rules of Practice, 37 C.F.R. Part 2, and the Office's *Trademark Manual of Examining Procedure* (TMEP) (4th ed., 2005), available on the United States Patent and Trademark Office web site at <http://www.uspto.gov/main/trademarks.htm>.

/kbp/

Kimberly Boulware Perry

Attorney - Law Office 112

phone: 571-272-9208; fax: 571-273-9112

direct email: kimberly.perry@uspto.gov

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date.** To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

Print: Apr 4, 2006

78225023

TYPED DRAWING

Serial Number
78225023

Status
REGISTERED

Word Mark
EROZONE

Standard Character Mark
No

Registration Number
3071704

Date Registered
2006/03/21

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
Megasol Cosmetic GmbH LTD LIAB JT ST CO FED REP GERMANY
Jean-Monnet-Strasse 6 Foehren FED REP GERMANY 54343

Goods/Services
Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S:
massage oils, excluding preparations for moisturizing or tanning the
skin or for protecting the skin or hair from the effects of
ultraviolet radiation. First Use: 2000/12/19. First Use In Commerce:
2000/12/19.

Goods/Services
Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S:
Gels for use as a personal lubricant, medical lubricant, namely,
vaginal lubricants, water-based personal lubricants. First Use:
2000/12/19. First Use In Commerce: 2000/12/19.

Filing Date
2003/03/13

Examining Attorney
TAYLOR, DAVID

Print: Apr 4, 2006

78225023

Attorney of Record
David Toren